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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/898,456 | 07/03/2001 | Carl Johan Friddle | LEX-0198-USA | 8160 |

24231 7590 10/01/2003

LEXICON GENETICS INCORPORATED
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THE WOODLANDS, TX 77381-1160

EXAMINER

HAYES, ROBERT CLINTON

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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1647

DATE MAILED: 10/01/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/898,456

Applicant(s)

FRIDDLE ET AL.

Examiner

Robert Hayes

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 December 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-8 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1 (in part), 2 and 3, drawn to isolated nucleic acid molecules corresponding to SEQ ID NO: 1, or encoding the polypeptide of SEQ ID NO: 2, classified in class 536, subclass 23.1, for example.
- II. Claims 1 (in part) and 4, drawn to isolated nucleic acid molecules corresponding to SEQ ID NO: 3, or encoding the polypeptide of SEQ ID NO: 4, classified in class 536, subclass 23.1, for example.
- III. Claims 1 (in part), 5 and 6, drawn to isolated nucleic acid molecules corresponding to SEQ ID NO: 6, or encoding the polypeptide of SEQ ID NO: 7, classified in class 536, subclass 23.1, for example.
- IV. Claims 1 (in part) and 7, drawn to isolated nucleic acid molecules corresponding to SEQ ID NO: 18, classified in class 536, subclass 23.1, for example.
- V. Claims 1(in part) and 8, drawn to isolated nucleic acid molecules corresponding to SEQ ID NO: 8, classified in class 536, subclass 23.1, for example.
- VI. Claim 1 (in part), drawn to isolated nucleic acids corresponding to nucleic acids encoding SEQ ID NO: 11, classified in class 536, subclass 23.1, for example.

- VII. Claim 1 (in part), drawn to isolated nucleic acids corresponding to nucleic acids encoding SEQ ID NO: 13, classified in class 536, subclass 23.1, for example.
- VIII. Claim 1 (in part), drawn to isolated nucleic acids corresponding to nucleic acids encoding SEQ ID NO: 15, classified in class 536, subclass 23.1, for example.
- IX. Claim 1 (in part), drawn to isolated nucleic acids corresponding to nucleic acids encoding SEQ ID NO: 17, classified in class 536, subclass 23.1, for example.
- X. Claim 1 (in part), drawn to isolated nucleic acids corresponding to nucleic acids encoding SEQ ID NO: 21, classified in class 536, subclass 23.1, for example.
- XI. Claim 1 (in part), drawn to isolated nucleic acids corresponding to nucleic acids encoding SEQ ID NO: 23, classified in class 536, subclass 23.1, for example.

The inventions are distinct, each from the other because of the following reasons:

Although there are no provisions under the section for "Relationship of Inventions" in M.P.E.P. § 806.05 for inventive groups that are directed to different products, restriction is deemed to be proper because these products constitute patentably distinct inventions for the following reasons. Groups I-XI are directed to products that are distinct both physically and functionally, are not required one for the other, and are therefore patentably distinct. Each sequence requires its own search.

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therefore, a search of all of the sequences in a single patent application would present an undue search burden to the USPTO.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, and separate search requirements, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Hayes, Ph.D., whose telephone number is (703) 305-3132.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Kunz, Ph.D., can be reached on (703) 308-4623. The fax phone

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number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

ECK

Elizabeth C. Kemmerer

ELIZABETH KEMMERER
PRIMARY EXAMINER